

Application No. 10/828,780

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Docket No.: 30610/40001

REMARKSClaim Status

Claims 1 - 57 are pending in the present application. Herein, Applicants present no amendments, add no new claims, and cancel no claims. No additional claims fee is believed to be due. Applicants request reconsideration in light of the following remarks.

Response to Restriction Requirement: Election

The Examiner has required, under 35 U.S.C. §121, election of a single disclosed invention for prosecution on the merits. The Examiner has divided the claims as follows:

Group I, claims 1-14, and 52-57, drawn to a glycosaminoglycan measuring device comprising a sample entry port, a glycosaminoglycan separation cartridge and a detection apparatus comprising a detection chamber coupled to the separation cartridge;

Group II, claims 15-23, drawn to a glycosaminoglycan measuring device comprising a sample entry port, a separation cartridge and a detection apparatus;

Group III, claim 24, drawn to a glycosaminoglycan measuring device comprising a sample entry port, a separator means and detection means;

Group IV, claims 25-51, drawn to a method for measuring glycosaminoglycans by automatically delivering a portion of the sample to a glycosaminoglycan separation cartridge separating the glycosaminoglycan from interfering substances using the cartridge and detecting the amount of glycosaminoglycans

Pursuant to this requirement, Applicants hereby elect, with traverse, to prosecute the invention designated in the Action as Group III, claim 24.

Applicants reserve the right to petition the restriction, and reserve the right to rejoin the non-elected claims upon allowance of elected claim(s).

Traversal of Restriction Requirement

Applicants traverse on the grounds that the restriction is improperly made. MPEP §803 sets forth the criteria for any restriction requirement, providing that:

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There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required.

The Examiner asserts that these inventions are distinct. Applicants respectfully submit that the claims of Groups I – IV are closely interrelated and for consistency of prosecution, all the Groups should be prosecuted in the same application. All of the Groups involve devices to measure glycosaminoglycans (GAGs) comprising a sample entry port, a separation means and a detection means, and methods to use said devices. Maintaining the Examiner's restriction requirement will result in a piece-meal prosecution, contrary to the policy set forth in the MPEP and by the courts. Therefore, Applicants request that the restriction requirement be withdrawn.

Another necessary criterion stated by MPEP §803 for restriction requirements is the unduly burdensome effect on the Examiner to search the relevant art. In this instance, the Office Action has noted four Groups, however, Groups I, II and III (claims 1-14, and 52-57, and claim 24, respectively) are all directed to devices to measure glycosaminoglycans comprising a sample port, a means for separation and a means for detection. Because the Groups overlap, a proper search for any one of the Groups would require a search of these three elements encompassing all of the claims of Groups I-III and moreover would require a search in all three of the classes that the Examiner has identified as containing potentially relevant art. A search conducted in only one class would not be a proper search, and if the Examiner searches all of the classes, it would not be unduly burdensome to examine all of the claims. submit that the claims of at least Groups I - III should be examined together as a single invention.

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Conclusion

This response represents a bona fide effort to place the application in proper form. In view of the foregoing, reconsideration of this application and allowance of claims 1-57 is respectfully requested.

Dated: December 21, 2006

Respectfully submitted,

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